The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JORG HOFFMANN, PIETER OOMS,
PRAMOD GUPTA, MICHAEL SCHNEIDER
and WALTER SCHAFER

Appeal No. 2005-2319
Application No. 09/582,141

ON BRIEF

Before KIMLIN, WARREN and OWENS, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-7, 9 and 10. Claim 1 is illustrative:

1. A double-metal cyanide (DMC) catalyst comprising:

a) a double metal cyanide compound;

b) an organic complexing ligand; and

c) 2 to 80 wt.%, based on the amount of finished catalyst, of an aliphatic polycarbonate having hydroxyl end groups and an average molecular weight below 12,000, as determined by measurement of the OH number.

The examiner relies upon the following reference as evidence of obviousness:

Le-Khac	5,714,428	Feb. 3, 1998

The present application was previously before this Board. In a decision dated April 23, 2003, the Board affirmed the examiner's rejection under 35 U.S.C. § 103 of similar claims directed to a double-metal cyanide (DMC) catalyst composition comprising essentially the same three components. The § 103 rejection in the prior appeal was based on the same Le-Khac reference presently applied by the examiner. The claims in the instant appeal now specify that the polycarbonate component is "an aliphatic polycarbonate having hydroxyl end groups and an average molecular weight below 12,000, as determined by measurement of the OH number." Hence, the only difference between claim 1 of the prior appeal and claim 1 of the present appeal is that appellants now specify that the polycarbonate is an aliphatic one having a particular molecular weight range.

Appealed claims 1-7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Le-Khac.

Appellants submit at page 3 of the Brief that "Claims 1-7, 9 and 10 stand or fall together." Accordingly, all the appealed claims stand or fall together with claim 1.

We have carefully reviewed each of appellants' arguments for patentability. However, we fully concur with the examiner that the claimed subject matter would have been obvious to one of ordinary skill in the art within the meaning of § 103 in view of the applied prior art. Accordingly, we will sustain the examiner's rejection for the reasons set forth in the Answer, which we incorporate herein, and we add the following for emphasis only.

There is no dispute that the applied reference discloses DMC catalyst compositions comprising (a) a double-metal cyanide compound, (b) an organic complexing ligand, and (c) 2 to 80 wt.% based on the amount of finished catalyst of a polycarbonate (see the Abstract of Le-Khac, particularly the recited range for the amount of functionalized polymer). It is appellants' contention that "Le-Khac et al. provide a 'laundry list' of nine (9) broad classes of functionalized polymers (one of which is merely

denominated as 'polycarbonates') and provide a 'preferred' molecular weight range of virtually 500,000" (page 5 of Brief, second paragraph). However, as explained by the examiner and set forth in the prior Board decision, Le-Khac teaches that polycarbonates are one of the preferred functionalized polymers for the catalyst and, therefore, we agree with the examiner that one of ordinary skill in the art would have been properly motivated to select polycarbonates as a suitable functionalized polymer. Indeed, as emphasized by the examiner, Le-Khac exemplifies a specific species of polycarbonate that falls within the claimed sub-genus of an aliphatic polycarbonate having hydroxyl end groups, namely poly(1,6-hexanediol carbonate) (column 5, line 6).

As for the claimed average molecular weight below 12,000, we wholeheartedly endorse the examiner's reasoning that the preferred molecular weight range disclosed by Le-Khac, about 500 to about 50,000, would have motivated one of ordinary skill in the art to employ a poly-carbonate such as poly(1,6-hexanediol carbonate) having an average molecular weight below 12,000, particularly since Le-Khac discloses a specific value, 500, that falls within the claimed range. See Titanium Metals Corp. v.

Banner, 778 F.2d 775, 782, 227 USPQ 773, 779 (Fed. Cir. 1985); In re Wertheim, 541 F.2d 257, 267, 191 USPQ 90, 100 (CCPA 1976); Ex parte Lee, 31 USPQ2d 1105, 1106 (Bd. Pat. App. & Int. 1993).

We note that the facts of In re Jones, 958 F.2d 347, 350 [21 USPQ2d 1941, 1943] (Fed. Cir. 1992), cited by appellants at page 5 of the Brief, are quite different than the ones presently before us.

Although the examiner made reference to specification data in the Answer, we find no argument in appellants' Brief directed to unexpected results based upon any data, including that found in the specification. As a matter of fact, appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, which would serve to rebut the inference of obviousness established by the applied prior art.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN)
Administrative Patent Judge)
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CHARLES F. WARREN) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
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